

In re Application of: ONODA, Kenji
Serial No.: 10/757,383
Response to 08/11/2005 Office Action
Atty. Docket No.:MIZ71

REMARKS

By the *Office Action* of August 11, 2005, Claim 1 is pending in the Application, with Claim 1 being rejected. By the present *RCE with Response and Amendment*, Applicant cancels Claim 1 and adds Claims 2–5.

Applicant files the present *RCE with Response and Amendment* in an effort to move the case to issuance. No new matter is believed introduced by the present *RCE with Response and Amendment*. It is respectfully submitted that the present Application is in condition for allowance for the following reasons.

1. Priority

Applicant thanks the Examiner for the acknowledgment of Applicant's claim for foreign priority in the *Office Action*. Applicant respectfully submits, however, that Applicant's complete claim for priority is correctly and fully set forth in its *Preliminary Amendment*, which was submitted on June 14, 2004. By the present *RCE with Response and Amendment*, Applicant resubmits its *Preliminary Amendment* of June 14, 2004, which correctly posits the following as the first paragraph on page 1 of the application:

“This application is a continuation-in-part of the U.S. Application Serial No. 10/727,079, filed on December 2, 2003, which is identified by the title “Golf Club Head and Manufacturing Method Thereof,” having inventors Kenji Onoda, Katsuyuki Aizawa, and Philip Chuang which claimed priority from Japanese patent application 2002-349443, filed December 2, 2002. This application also claims priority from Japanese patent application numbers 2003-020349, 2003-020348, and 2003-020347, all filed on July 14, 2003.”

(See *Preliminary Amendment* at pp.1-2, attached hereto as Appendix A). This paragraph fully and completely sets forth Applicant's claims to priority.

Applicant also thanks the Examiner for the notation that Applicant has yet to file certified copies of the foreign applications to which priority is claimed. By the present *RCE with*

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Response and Amendment, Applicant attaches hereto certified copies of all foreign applications to which priority has been claimed as set forth above, including Japanese patent application numbers 2003-020349, 2003-020348, and 2003-020347. (Attached hereto as Appendix B). Therefore, Applicant submits that its claims to priority under 35 U.S.C. §§ 119-120 are perfected.

2. Specification

The *Office Action* asserts that the disclosure is objected to because the US application to which Applicant seeks to claim priority, is not listed in the specification. Applicant respectfully directs the Examiner to its previously filed *Preliminary Amendment* of June 14, 2004. This *Preliminary Amendment* requests that the first paragraph of page of 1 of the application be replaced with the paragraph set forth in the *Preliminary Amendment*, as copied above. Applicant resubmits this *Preliminary Amendment* by the present *RCE with Response and Amendment*. (Appendix A). The replacement paragraph provided by the *Preliminary Amendment* properly sets forth the required information for the US priority document, U.S. Application Serial No. 10/727,079. Thus, Applicant's claim to priority under 35 U.S.C. §120 is believed to be perfected.

3. Claim Rejections Under 35 U.S.C. § 102

Claim 1 is rejected as unpatentable under 35 U.S.C. § 102(e) as being anticipated by Nakahara et al. (2003/0083151). Due to the pending parent case for which the current Application is a continuation-in-part, Claim 1 is cancelled as redundant of claims in the parent application.

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4. New Claims 2-5

With the present *RCE with Response and Amendment*, Applicant adds Claims 2-5 to further identify the invention. Claims 2-5 are directed to material disclosed within the *Specification*, and Applicant believes that Claims 2-5 are allowable.

No new matter is believed to be introduced by these claims as they are fully supported by the *Specification*, including page 7 of the *Specification*, and figures 5-7 of the *Drawings*. Accordingly, Applicant respectfully submits that Claims 2-5 are in condition for allowance.

5. Fees

Other than the RCE fee and three month extension of time, no other fees are believed due. The Commissioner is, however, hereby authorized to charge any other fees that may be required, or credit any overpayment, to Deposit Account No. 20-1507.

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CONCLUSION

By the present *RCE with Response and Amendment*, the Application has been placed in full condition for allowance. Accordingly, Applicant respectfully requests early and favorable action. Should the Examiner have any further questions or reservations, the Examiner is invited to telephone the undersigned Attorney at 404.885.3622.

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NAME APPLICATION OF)	EXAMINER: unassigned
Onoda)	
)	
APPLICATION SERIAL NO.)	GROUP ART UNIT 3711
10/757,383)	
FILED: January 14, 2004)	
)	
TITLE: COMPOSITE METALWOOD)	ATTY. DOCKET NO.
)	MIZ71

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 14, 2004.

Gerald R. Boss, Reg. No. 36,460

Gerald R. Busch, Reg. No. 5, 100

Signature

PRELIMINARY AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Prior to receipt of the first Office Action in this case, Applicant's attorney requests that the first paragraph on page 1 of the application be replaced with the following paragraph:

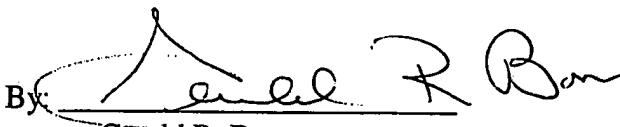
This application is a continuation-in-part of the U.S. Application Serial No. 10/727,079, filed on December 2, 2003, which is identified by the title "Golf Club Head and Manufacturing Method Thereof," having inventors Kenji Onoda, Katsuyuki Aizawa, and Philip Chuang which

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Applicant: Onoda et al.

claimed priority from Japanese patent application 2002-349443, filed December 2, 2002. This application also claims priority from Japanese patent application numbers 2003-020349, 2003-020348, and 2003-020347, all filed on July 14, 2003.

No fees are believed to be due in connection with this Preliminary Amendment. However, the Commissioner is authorized to debit deposit account No. 20-1507 if any such fees are due.

Respectfully submitted,

By: 
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